

REMARKS

Claims 1-15 are all the claims pending in the application.

Preliminary Matters

Applicant respectfully requests that Examiner acknowledge the claim for foreign priority and indicate whether the formal drawings filed September 28, 2001 have been accepted.

Claim Rejections - 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 1-11 under § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner alleges that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In support of this rejection, the Examiner states that claims 1, 3, 4, 9, 10 and 11 contain the phrase “two sorts of devices as well,” and that this phrase is confusing and the specification does not provide a clear explanation of the meaning of the phrase, therefore the claims are not enabled. Claims 2 and 5-8 are rejected because they depend upon these rejected claims.

Applicant traverses this rejection as follows.

First, Applicant submits that the Examiner has not met his burden under MPEP § 2164.04. To meet this burden, it is necessary for the Examiner to construe the claims before performing any analysis of enablement. In this rejection, the Examiner has failed to do so. Instead, the Examiner merely states in a conclusory fashion that the phrase “two sorts of devices

as well,” is confusing, and since the specification does not provide for a clear explanation of the meaning of this phrase, the claims are not enabled.

To the contrary, it is necessary that the Examiner select the definition that he/she intends to use when examining the application, based on his/her understanding of what the Applicant intends it to mean, and explicitly set forth the meaning of the term and the scope of the claim when writing an Office action.¹ Furthermore, in order to make a rejection, the Examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention.² Merely claiming that the term is confusing is not enough.

Thus, because the Examiner has not attempted to construe this terminology and admits that it is confusing without attempting to construe the term or phrase, the enablement rejection under 35 U.S.C. § 112, first paragraph, is improper and should be withdrawn.

Claim Rejections - 35 U.S.C. § 112, Second paragraph

The Examiner rejected claims 1-11 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that the phrase “two sorts of devices as well” is confusing and that no clear explanation is given for the meaning of the phrase. Applicant traverses this rejection as follows.

¹ See Genentech v. Wellcome Foundation, 29 F.3d 1555, 1563-64 (Fed. Cir. 1994)

² In re Wright, 999 F.2d 1557, 1562 (Fed. Cir. 1993)

Applicant submits that this phrase is clearly supported by the specification. First, a portion of the Background of the Invention exemplifies several non-limiting uses of the term device: “for displaying color reproduction characteristics defined in accordance with a device for mediating between image date and an image, for example, an input device for converting an image to image data, such as a color scanner and a digital still camera, and an output device (including a display device for outputting or displaying an image on a display screen, such as a display unit and the like) for outputting an image in accordance with image data, such as a printing machine and a printer.” (Application, pg. 1, lines 10-19) Thus, some non-limiting examples of devices are color scanners, digital still cameras, displays, printing machines and printers. Thus, Applicant submits that the specification clearly explains, by example of non-limiting embodiments, what this phrase means. For example, the phrase may mean by way of non-limiting examples: two sorts of printers, a printer and a display, a printer and a printing machine, etc.

Thus, Applicant requests that the Examiner withdraw this rejection.

Further , because the Examiner is obligated to consider all the claims on the merits, notwithstanding any purported § 112 deficiencies, any new prior art rejections must be made on a non-final basis. (MPEP § 2143.03)

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

Amendment Under 37 C.F.R. § 1.111
U.S. Appln No. 09/964,496

Atty Dkt No. Q66005

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



David P. Emery
Registration No. 55,154

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: April 18, 2006